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EXAMINER

MOHANDESI, JILA M

ART UNIT PAPER NUMBER

3728

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,016

Applicant(s)

GANTIER, ALAIN

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-44 and 46-61 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 14-23, 25-44 and 46-61 is/are rejected.
7) ☒ Claim(s) 24 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03-29-2004.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 14, 49, 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Said rigid or semi-rigid cover being more rigid than said upper front surface and said flexion fold zone of the shoe so as to interfere with free flexing of the shoe while a wearer's foot is positioned within the shoe, is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. It is noted that the term "snowboard boot" in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

5. Claims 14-18 and 20-23, 25-26, 28, 49 and 50, 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellis (3,206,874). Ellis '874 discloses an assembly comprising: a shoe and a device (foot protector 34 with guard flap 36) for flexural stiffening and/or protection of the shoe; said shoe comprising: an upper including a flexion fold zone, an upper front surface, a flexible front end zone; and a sole; said device including a rigid cover being more rigid than said upper front surface and said flexion fold zone of the shoe, since the cover is more rigid than the upper front surface (specially when made of metal), it will inherently interfere with the free flexing of the shoe to some extent.

With respect to claims 16, 17 and 20-22, note the journal connection/insert (hinge 40 and plate 38) in Figures 1 and 2 embodiments.

With respect to claim 23, the insert (40 & 38) is on opposite sides of said sole.

With regard to claim 25 and the material of the cover, see column 3, lines 2-6.

With regard to claim 26 and the immobilizing means, note the rivet (45) in Figures 1 and 2 embodiments.

6. Claims 14-18 and 20-22, 25-26, 28, 49 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Donnell (3,068,593). O'Donnell '593 discloses an assembly comprising: a shoe and a device (relatively rigid foot protector flap 32) for flexural stiffening and/or protection of the shoe; said shoe having a flexion fold zone, an

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upper front surface, a front end zone, said device including a cover covering said upper front surface of said shoe and extending from said flexion fold zone of said shoe to said front end zone of said shoe.

With respect to claims 16, 17 and 20-22 note the journal connection/insert (furrules 31 and studs 36) in Figures 1-4 embodiments.

With regard to claim 25 and the material of the cover, see column 2, lines 27-29.

With regard to claim 26 and the immobilizing means, note the screw (41) in Figures 1-4 embodiments.

7. Claims 14 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards et al. (3,334,427). Edwards' 427 discloses an assembly comprising: an article of footwear and a device (22 & 32) for increasing flexural rigidity and protection of the article of footwear; said article of footwear including an upper and a sole, said upper including a flexion fold zone, an upper front zone and an upper rear zone; said upper front zone of said upper being contiguous with and extending above said flexion fold zone in an upward direction to adapt the upper front zone to be positioned forward of a lower leg of a wearer of the article of footwear; said upper rear zone of said upper extending in said upward direction to adapt the upper rear zone to be positioned rearward of the lower leg of the wearer of the article of footwear; a front end zone of said upper extending in a direction forward of said flexion fold zone; said device for increasing flexural rigidity and protection of the article of footwear comprising a cover having three parts, said three parts including a rigid intermediate part, an upper part, and a rigid lower part; said intermediate rigid part of said cover covering said flexion fold

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zone of said article of footwear; said rigid lower part of said cover extending forwardly from said intermediate part of said cover along an area above said front end zone of said article of footwear; said upper part of said cover extending upwardly from said intermediate part of said cover along an area in front of said upper front zone of said upper of said article of footwear, said upper part of said cover extending substantially in said upward direction of the front and rear zones of said upper of said article of footwear. See Figures 1-5 embodiments.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '874 in view of Cataffo '553. Ellis '874 as described above discloses all the limitations of the claims except for the device extending from a tibial support zone to a metatarsophalangeal articulation zone.

Cataffo '553 discloses that it is desirable to have a device extending from a tibial support zone to a metatarsophalangeal articulation zone to give better protection to this area of the boot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of Ellis '874 extend from a tibial support zone to a metatarsophalangeal articulation zone as taught by Cataffo '553 to provide better protection for this area of the boot.

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Ellis '874 discloses that the cover can be made of different materials which inherently will have different rigidity. (see column 3, lines 2-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of covers made from different materials having varying rigidities, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

10. Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell '593 in view of Cataffo '553. O'Donnell '593 as described above discloses all the limitations of the claims except for the device extending from a tibial support zone to a metatarsophalangeal articulation zone. Edwards '427 discloses that it is desirable to have a device extending from a tibial support zone to a metatarsophalangeal articulation zone to give better protection to this area of the boot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of O'Donnell '593 extend from a tibial support zone to a metatarsophalangeal articulation zone as taught by Cataffo '553 to provide better protection for this area of the boot.

11. Claims 15, 18, 19, 20, 22, 26, 27, 28, 29, 30, 31, 33, 35, 38, 39, 40, 41, 42, 43, 44, 48, and 50-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards '427 in view of Cataffo (2,249,553). Edwards '427 as described above discloses all the limitations of the claims except for said cover being made of a single piece of rigid or semi-rigid material in an entirety of a longitudinal extent of the cover.

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Cataffo '553 discloses that it is desirable to provide a cover that is made of a single piece of rigid or semi-rigid material in an entirety of a longitudinal extent of the cover for better protection of the foot and ankle. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cover of Edwards '427 of a rigid or semi-rigid material in an entirety of a longitudinal extent of the cover as taught by Cataffo '553 for better protection of the foot and ankle.

Edwards '427 discloses different materials, which inherently will have different rigidity. (see column 3, lines 2-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of covers made from different materials having varying rigidities, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

With respect to claim 33, note the tightening strap/lace in Figure 3 embodiment.

With respect to claims 44 and 58, since snowboards have bindings and the boot of Edwards '427 can be fastened to the binding of the snowboard, therefore the boot can fit in the binding of a snowboard and can be considered as a snowboard boot.

12. Claims 16, 17, 21, 23, 25, 36, 37, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claims 15, 20, 22 and 44 above, and further in view of Ellis 874. Edwards '427 discloses that the device may be fastened to the article of footwear by any suitable means. Ellis '874 discloses a journal connection for connecting the device to the sole of the shoe. Accordingly, the skilled

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artisan would have been motivated to substitute the flexible hinge of Edwards '427 for the journal connection of Ellis '874 insofar as they are art-recognized equivalents.

13. Claims 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 29 above, and further in view of ETABLISSEMENTS JACQUES LANDRY (FR 2 361 837). Edwards '427 as modified above discloses all the limitations of the claims except for the specific location of the tightening straps. LANDRY discloses an assembly comprising: a shoe and a device (2) for flexural stiffening and/or protection of the shoe; said device comprising tightening straps extending rearwardly from a tibial support zone and downwardly from an instep zone of the article of footwear for better securing the device to the shoe. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide tightening straps at different locations of the device of Edwards '427 as taught by LANDRY to better secure the device to the shoe. since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

Allowable Subject Matter

14. Claim 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

15. Applicant's arguments with respect to claims 14-44 and 46-61 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JILA M. MOHANDESI
PRIMARY EXAMINER



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
June 24, 2004